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S/N 10/726,917

Response to Office Action Dated 05/03/2006

SEP 05 2006**REMARKS**

1 A review of the claims indicates that:

2 A) Claims 2—5, 9—12, 14, 16, 18—22, 24, 26—29, 32—35, 37 and 38
3 remain in their original form.

4 B) Claims 1, 6—8, 13, 15, 17, 23, 25, 30, 31 and 36 are currently
5 amended.

6 C) Claims 39—41 are new. These claims were “transferred from”
7 application number 10/727,240, titled “PPML to PDF Conversion”, as suggested
8 by the Examiner.

9 In view of the following remarks, Applicant respectfully requests
10 reconsideration of the rejected claims and withdrawal of the rejections.
11

12 **Claim Objections**

13 A number of abbreviations have been annotated with their respective
14 definitions.

15 **The Specification**

16 Paragraph [0001] has been amended to show the related applications.
17

18 **35 U.S.C. §112**

19 The antecedent issue in Claim 8 has been resolved.
20

21 **35 U.S.C. §101**

22 Claims 17 and 25 have been amended to recite “a computer system,”
23 thereby affirmatively reciting the limitation of a computer system within these
24 independent claims.
25

S/N 10/726,917

Response to Office Action Dated 05/03/2006

35 U.S.C. §103

Independent Claims 1, 13, 17, 25 and 36 have been rejected as being unpatentable over Kloosterman et al (US 2003/017926). The Applicant respectfully traverses the rejection, and requests reconsideration.

Note that Claim 39 is similar to these claims, and will be addressed in concert with them.

Traversal of Rejection of Independent Claim 1

Claim 1 recites a processor-readable medium comprising processor-executable instructions for processing a PDF document to produce a PPML template, the processor-executable instructions comprising instructions for comprising:

- opening the PDF document;
- converting a PDF element within the PDF document into a variable object;
- selecting a macro containing rules governing operation of the variable object; and
- configuring the PPML template to include a definition of the variable object, the macro and a version of the PDF document, wherein the version of the PDF document is configured as a background element within the PPML template.

Accordingly, Claim 1 recites in part, "converting a PDF element within the PDF document into a variable object". The Applicant respectfully submits that the Kloosterman reference does not disclose, teach or suggest any type of conversion of an element in a first document (e.g. the PDF document) to become a variable object configured within a second document (e.g. the PPML template, see the last paragraph of the Applicant's claim). Accordingly, the prior art does not disclose,

S/N 10/726,917

Response to Office Action Dated 05/03/2006

1 teach or suggest converting a PDF element into a variable object and configuring a
2 PPML template with a definition of that variable object.

3 Referring to the Applicant's Background Section, at [0004], the Applicant
4 notes that creation of a PPML document is difficult. However, once created, such
5 a document can be used in high-speed print jobs including large numbers of
6 customized documents (i.e. documents having variable data). Kloosterman
7 teaches such a prior art system, wherein the PPML document is created by a
8 PPML document creation tool (e.g. the authoring application of 0033, line 10).

9 Kloosterman teaches that a graphic artist can use an authoring application to
10 create a layout template having variable parts (see 0033, lines 11—13). Details of
11 such an authoring application are also seen at 0031, lines 18—24. Once created,
12 Kloosterman teaches that the PPML template is merged with content from a data
13 base, thereby creating a plurality of "instance documents," each of which is
14 different. See, for example, Kloosterman at 0039. Accordingly, Kloosterman
15 teaches that a PPML template (or similar) is authored from scratch, to include one
16 or more variables of text, graphics or image. The template is then merged with a
17 database to create the instance documents, which are rapidly printed.

18 Thus, Kloosterman fails to disclose, teach or suggest that *an element in an*
19 *already created document could be converted into a variable object for inclusion*
20 *within a PPML template*. Accordingly, Kloosterman has not disclosed a way to
21 leverage already created documents to create the PPML needed for high-speed
22 printing.

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S/N 10/726,917

Response to Office Action Dated 05/03/2006

1 The Patent Office points to Kloosterman at [0039] et sequence and suggests
2 that Kloosterman teaches or suggests converting a PDF element into a variable
3 object. The Applicant respectfully disagrees.

4 At [0039], Kloosterman teaches that the template created by the graphical
5 artist at [0033] (line 11) can be merged with a database to create 'instance
6 documents'. Thus at [0039], Kloosterman teaches that the template includes static
7 and variable elements. The variable elements *are filled* from the database 16 to
8 create instance documents. However, Kloosterman teaches that the variables *are*
9 *created* by a VDP authoring application (see 0033 at lines 9—11). Thus,
10 Kloosterman does not teach that an element in a PDF document is converted into a
11 variable object.

12 In summary, the Applicant has recited that an element within a PDF
13 document is converted into a variable object, a definition of which is included
14 within a PPML template. In contrast, Kloosterman teaches that a VDP authoring
15 application creates a template having variables (0033 at lines 7—13). Such
16 variables are then filled using a database (0039 at lines 5—7). Accordingly,
17 Kloosterman does not disclose, teach or even suggest that an element from a first
18 document (the PDF) could be converted to become a variable object for inclusion
19 within a second document (the template). (Note that the act of *creating* variables
20 in the PPML document is not to be confused with *filling* variables in such a
21 document.)

22 Thus, Kloosterman fails to teach or suggest converting an element into a
23 variable object, and including a definition of the variable object in a template.

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S/N 10/726,917

Response to Office Action Dated 05/03/2006

1 Accordingly, the Applicant respectfully requests that the Section 103 rejection be
2 removed.

3 **Claims 2—12** depend from Claim 1 and are allowable due to their
4 dependence from an allowable base claim. These claims are also allowable for
5 their own recited features that, in combination with those recited in Claim 1, are
6 neither disclosed nor suggested in references of record, either singly or in
7 combination with one another.

8 **Claims 13, 17, 25 and 36**, as well as the claims that depend from these
9 independent claims, were rejected using approximately the same grounds as the
10 rejection of Claim 1. Accordingly, the Applicant incorporates by reference the
11 remarks and arguments expressed therein.

12 **Traversal of Rejection of Dependent Claim 9**

13
14 A number of Dependent Claims were rejected under the single-reference
15 Section 103 rejection. While the Applicant feels that each dependent claim is
16 allowable as depending from a claim that is allowable for at least the above
17 reasons, the Applicant also submits that each dependent claim is allowable for
18 reasons associated with the elements recited by each claim itself. As one example
19 of this allowability, the Applicant discusses Claim 9, below.

20
21 **Claim 9** recites a processor-readable medium as recited in claim 1,
22 comprising further instructions for:

- 23 • **modifying the PDF document to include marking elements to**
24 **link the variable object with the macro.**
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S/N 10/726,917

Response to Office Action Dated 05/03/2006

1 Accordingly, Claim 9 recites, "modifying the PDF document to include
2 marking elements to link the variable object with the macro". The Applicant
3 respectfully submits that Kloosterman does not teach or suggest modifying a
4 document to include marking elements to link a variable object with a macro.

5 Referring to Kloosterman, a template including variable objects is created
6 by a VDP authoring application (see 0033 at lines 6—13). Thus, the variable
7 object is created by an authoring tool, and is not converted from an element in a
8 PDF document. Accordingly, Kloosterman teaches no PDF (or other type of)
9 document that is modified to include marking elements. In part because
10 Kloosterman fails to teach converting a PDF element within the PDF document
11 into a variable, Kloosterman fails to teach "marking elements" linking the variable
12 object with the macro.

13 The Patent Office suggests that Kloosterman at 0039 et sequence teach
14 marking elements to link the variable object with the macro. However, a review
15 of Kloosterman indicates that no document is modified to include marking
16 elements to link the variable object to the macro.

17 The Patent Office may be suggesting *that the template is marked* to link the
18 variables and the macro. However, the Applicant submits that marking the
19 template does not teach or suggest marking a PDF document, since the PDF
20 document of the Applicant's claim is distinct from the PPML template of the
21 Applicant's claim. Accordingly, assuming for the sake of argument that
22 Kloosterman marks the template, such marking does not teach or suggest the
23 Applicant's recited marking of the PDF document, since the Applicant recites two
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S/N 10/726,917

Response to Office Action Dated 05/03/2006

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1 distinct documents—the PDF document and the PPML template—and it is the
2 PDF document—not the PPML template—that is marked.

3 If the Patent Office persists with this rejection, further discussion would be
4 more productive if the Patent Office would point out exactly which document it is
5 proposed that Kloosterman modifies with marking elements, and where that is
6 taught in Kloosterman.

7 In the absence of teachings or suggestions or modifying a document to
8 include marking elements, the Applicant respectfully requests withdrawal of the
9 Section 103 rejection.

10 11 Conclusion

12 The arguments presented above are intended to present the Applicant's
13 position clearly, but should not be considered exhaustive. Accordingly, the
14 Applicant reserves the right to present additional arguments to clarify the
15 Applicant's position further. Moreover, the Applicant reserves the right to
16 challenge the status as prior art of one or more documents cited in the Office
17 Action.

18 The Applicant submits that the claims as presented are in condition for
19 allowance. Accordingly, the Applicant respectfully requests that a Notice of
20 Allowability be issued. If the Patent Office's next anticipated action is not the
21 issuance of a Notice of Allowability, the Applicant respectfully requests that the
22 undersigned attorney be contacted to schedule an interview.

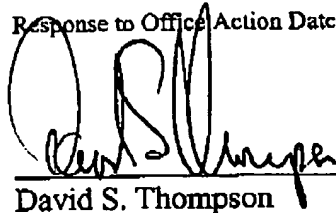
23 Respectfully Submitted,
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S/N 10/726,917

Response to Office Action Dated 05/03/2006

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